



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

the Application of
Eileen White et al.

Serial No.: 09/674,876

Filed: December 12, 2001

For: "Recombinant Cell Line
And Screening Method for
Identifying Agents Which
Regulate Apoptosis and
Tumor Suppression"

Examiner: Misook Yu
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)Art Unit: 1642

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)Response to Paper No. 11

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TRAVERSAL AND REQUEST FOR
RECONSIDERATION OF REQUIREMENT FOR RESTRICTION

Sir:

Applicants, through their undersigned attorneys, hereby traverse the requirement for restriction set forth in the July 3, 2002 Official Action issued in the above-identified patent application. The Examiner contends that the originally filed claims were directed to six (6) distinct inventions. These were as follows:

It is the Examiner's position that the application describes five (5) distinct inventions. These are as follows:

Group I: Claims 1-3, drawn to a method for assessing activity of the p300-responsive promoter;

Group II: Claims 4 and 5, drawn to a method for assessing binding between two proteins;

Group III: Claim 6, drawn to a method for detecting btf nucleic acid;

Group IV: Claim 7, drawn to a method for detecting btf protein; and

Group V: Claim 8, drawn to making btf protein.

Applicants respectfully submit that the restriction requirement set forth above is improper for failure to comply with the relevant provisions of the Manual of Patent Examining Procedure (M.P.E.P.) pertaining to unity of invention determinations.

The present application was filed under 35 U.S.C. §371 as a U.S. national stage application under the Patent Cooperation Treaty.

As stated in § 1893.03(d) of the M.P.E.P.:

Examiners are reminded that unity of invention (~~not restriction~~) practice is applicable in international applications (both Chapter I and II) and in national stage (filed under 35 U.S.C. 371) applications...

The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept.

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed

invention, considered as a whole, makes over the prior art.... Note also examples 1-17 of Annex B Part 2 of the PCT Administrative Instructions as amended 01 July 1992 contained in Appendix AI of the M.P.E.P.

It is noteworthy that, during the international stage of this application, no lack of unity was identified in either Chapter I or Chapter II of the PCT.

Plainly, the restriction requirement of July 3, 2002 fails to comply with the established United States Patent and Trademark Office practice of following the international rules regarding unity of invention in the prosecution of applications filed under § 371 and should be withdrawn.

In order to be fully responsive to the above-mentioned requirement, Applicants hereby elect the subject matter of Group I for consideration in this application, namely claims 1-3 drawn to a cell line and methods of use thereof for screening therapeutic agents for p300 inhibitory activity, thereby inducing apoptosis.

Applicants hereby reserve the right to file one or more continuing applications, as provided in 35 U.S.C. §120, on the subject matter of any claims finally held withdrawn from consideration in this application.

Early and favorable action on the merits of this application is respectfully solicited.

Respectfully submitted,

DANN DORFMAN HERRELL and

SKILLMAN, P.C.

Attorneys for Applicant

By 

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In re the Application of :
Eileen White, et al. : Examiner: Misook Yu
: Group Art Unit: 1642
Serial No. 09/674,876 : Response to Paper No. 11
Filed: November 7, 2000 :
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SCREENING METHOD FOR IDENTIFYING :
AGENTS WHICH REGULATE APOPTOSIS :
AND TUMOR SUPPRESSION :
: **RECEIVED**
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July 24, 2002
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Jane C. Bogan
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